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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,863	02/16/2001	Jafar Nabkel	020366-066900	6341

20350 7590 08/11/2003

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

AL AUBAIDI, RASHA S

ART UNIT

PAPER NUMBER

2642

DATE MAILED: 08/11/2003

23

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 23

Application Number: 09/785,863

Filing Date: February 16, 2001

Appellant(s): NABKEL ET AL.

Irvin E. Branch

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06/13/2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that the claims stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,373,817	KUNG ET AL	04-2002
5,222,120	MCLEOD ET AL	06-1993

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5, 8-16, 19-27 and 30-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLeod et al (US PAT# 5,222,120) in view of Kung et al. (US PAT #6,373,817).

Regarding claim 1, McLeod teaches a communication network comprising a plurality of subscriber telephone lines (see col.2, lines 18-20), each coupled to an associated telephoning switching facility, each subscriber telephone line having at least one directory number and an associated subscriber profile including selected information services, a method for providing information services to a subscriber, comprising: detecting an off-hook condition at a subscriber telephone line (this feature is inherent) ; determining the information services selected by the subscriber (reads on customer profile, col.24, lines 45-57) by correlating the subscriber directory number with the selected information services in the subscriber's profile ("customer data record" or "information system") in accordance with predetermined criteria (see col.4, lines 29-32),

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generating a message corresponding to the selected information services for receipt by the subscriber. On one hand, both references, Kung and McLeod, teach the use of scheduling, time, date and day of the week. McLeod teaches that the scheduling information includes the date and time (see col. 35, lines 41-43). Kung teaches in his system a schedule, which shows the time of the day and day of the week (see Fig. 7a-7b). On the other hand, the predetermined criteria which includes the time, date or day of the week in the subscriber's profile would obviously reflect how often a service such as the news or the weather would be provided. The subscriber would obviously not want to listen to the weather report every 5 minutes.

McLeod does not teach generating a message "in response to the off-hook condition" detection.

However, Kung et al teach the announcement server 220 may detect the off-hook condition of the phone and play advertisements or other announcements to the user, (see col. 10, lines 13-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature of generating a message or an announcement in response to an off hook detection, as taught by Kung, into the McLeod's system in order to provide the user with the convenience of accessing the required service such as the news, updates of the stock market, or the weather without

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the need to dial or memorize any access number. Also, Kung teaches a business agreement such as reduced phone rates may be provided to users who agree to listen to announcement when they go off-hook.

Claims 16 and 27 are rejected for the same reasons as respect to claim 1.

Regarding claim 2, McLeod teaches the message is an audio message (see col.24, lines 29-39).

Regarding claims 9,10, 20,21,31, and 32, McLeod teaches that while receiving the message, or after the message completes, entering one of a plurality of codes by the subscriber accesses additional information, and entering a code by the subscriber accesses the subscriber's correspondence messaging service (see col.24, lines 58-68).

Regarding claims 12,23, and 35 McLeod teaches the communication network is a public switched telephone network.

Regarding claims 14, 25 and 36, McLeod teaches that the subscriber selects an appropriate calling number by generating DTMF (dual tone multi-frequency) tones (see col. 25, lines 43-45).

Regarding claims 15, 26, and 37, the message is terminated when the subscriber goes "on hook" by hanging up the line. (The feature is inherent in McLeod; hanging up will end the transmission of the message).

Regarding claims 3-5, the use of different types of messages such as text, video, and graphic message would have been obvious to one of ordinary skill in the art at the time the invention was made since the use of multimedia messages is well known and desired. Furthermore, the use of multimedia messages is well known in the art, very common, widely used and also taught by Kung which teaches (col. 4, ll 35-38) that customer premise equipment 102 (Fig. 1) may be a "television (TV), personal computer (PC), plain old telephone system (POTS) phone(s), video phones, IP enabled phones, and other devices".

Regarding claims 8, 19, and 30, for the predetermined criteria includes the time since the last detected "off-hook" condition. This simply reads on the subscriber's choice of having the service provided during certain times or after making certain number of phone calls. This also may be an agreement between the business and the subscriber in Kung.

Regarding claims 13, 24, and 35, for selecting an appropriate calling number by the subscriber terminates the message. This is obvious because dialing should step the announcement.

Regarding claims 11,22, and 33, having the communication-network is an advanced intelligent network (AIN) this simply reads on using the features in an Advanced Intelligent Network.

Claim 38 is rejected for the same reasons as discussed above with respect to claim 1. In addition, the frequency of providing the information reads on the same scheduling features that were addressed in claim 1 such as time, date and day of the week. Thus, the frequency here means how many times the subscriber would like to listen to the weather, sport or stock for example.

(11) *Response to Argument*

On page 5, lines 2-4, of the brief, Appellant argues that “[n]othing in McLeod suggests providing information services upon detection of an “off hook” condition of the subscriber’s phone nor the delivery of information except by means of the audible menu”. Examiner agrees that McLeod does not provide the information in response to “off hook” detection and that is why the 103 rejection is based on the combination of McLeod and Kung. Kung teaches the “off hook” feature as clearly discussed in the rejection. As for the information in McLeod being only in an audible format, first, independent claims 1, 16, 27 and 38 merely recite generating “a message” (claim 1), “audio message” (claims 16 and 27) and “information service” (claim 38). Thus, the independent claims and the majority of the dependent claims read on the “audio

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message” as taught by McLeod. Second, dependent claims 3-5, the only claims that differ from an audio message, recite the use of multimedia messages such as text, video and graphic messages.

Claims 1, 16 and 27, recite “each subscriber telephone line having at least one directory number and an associated subscriber profile including selected information services”. The associated switching facility (e.g., the telephone company central office) inherently has a subscriber profile for every telephone line. The subscriber’s profile contains information about the services used by the subscriber such as caller ID, call waiting and call forwarding, and also the subscriber’s choice for long distance carrier (e.g., AT&T, Sprint... etc.). The services provided by the telephone switching facility are always customized based on the desires and needs of the subscriber. In addition to the use of “subscriber profile” being inherent, it is also taught by McLeod (reads on customer profile, col.24, lines 45-57) and suggested by Kung (see col.10, lines 20).

Appellant argues (Brief, page 5, lines 6-8 and page 7 lines 27-30) that in response to the off-hook detection, Kung plays a “random advertisement” to the user. This is simply incorrect. There is absolutely nothing random about the announcement in Kung. The word “random” is simply not in Kung. Kung teaches tracking users’ “income, age, or other profile” which suggests customizing advertisements accordingly. It is unpractical and insensitive to play an advertisement about buying a luxury boat to a family of very limited income. It is a waste of time to play an advertisement about a

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student loan, or a new local bar to a 80-year old user. Using random advertisements is not a smart way to advertise and it is not utilized by Kung.

It is common sense, logical and common knowledge that a business agreement between the subscriber and the "telephone company" will have to be somewhat convenient to the customer, possibly useful, possibly informative and definitely not annoying and at the same time will have to be beneficial to the advertiser. Playing an advertisement about a show in Washington DC to a caller in Hawaii is simply "bad" to both sides of the business agreement. Advertisements must be customized based on the customer's profile (age, income as suggested by Kung and obviously location). The use of "time, date or day of the week" is absolutely critical and obvious feature. For example, some one does not want to listen to an advertisement (such as weather report or the stock) at 2 am when trying to call 911 in an emergency situation. In another case the subscriber would obviously not want to listen to the weather report every 5 minutes. Customizing services based on the customer's profile is well known in the art. The use of time and scheduling is clearly taught by McLeod (col.35, lines 41-43) and Kung (see Fig.7a-7b). Another example, if a subscriber is a small business owner (home business) or participates in work at home program, he/she should ask the telephone company to play advertisements during weekend only.

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In conclusion, customizing subscriber profile is well known, suggested by McLeod and Kung. The use of time with customizing the profile is critical and obvious as discussed above.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Rasha S. Al-Aubaidi
August 8, 2003

Conferees

Ahmad F. Matar, SPE



AHMAD MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Rasha S. Al-Aubaidi, Examiner



William J. Deane, Jr, Primary Examiner



WILLIAM J. DEANE, JR.
PRIMARY EXAMINER

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TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834